

REMARKS

Claim 26 has been amended and new claims 61-73 have been added. Accordingly, claims 1-73 are pending.

Applicants thank Examiner Azpuru for extending the courtesy of a telephone interview conducted with Applicants' representative on April 14, 2005.

I. **Invention:**

The invention is directed to biodegradable and/or bioabsorbable fibrous articles, which include a composite (and, in one embodiment, an asymmetric composite) of different biodegradable and/or bioabsorbable fibers. Specifically, claims 1-48 are directed to such articles formed by electrospinning fibers of biodegradable and/or bioabsorbable fiberizable material, with claims 1-25 directed to a composite and claims 26-48 directed to an asymmetric composite.

The invention is also directed to a fibrous article formed by electrospinning different fibers of different materials, which includes a composite of different fibers having fibers of at least one biodegradable material and fibers of at least one non-biodegradable material (claims 49-51).

The invention is also directed to a method for reducing surgical adhesions using a biodegradable and/or bioabsorbable membrane (claims 52-55) and a method for providing controlled tissue healing using a biodegradable and/or bioabsorbable fibrous article (claims 56-60).

II. Amendments:

Claim 26 was amended to depend from claim 1, since an asymmetric composite is a subcategory of a composite. No new matter has been added.

New claims 61-73 are directed to biodegradable and/or bioabsorbable fibrous articles, which include a composite of different biodegradable and/or bioabsorbable fibers. These claims were added to cover such fibrous articles without the requirement of being formed by electrospinning fibers of biodegradable and/or bioabsorbable fiberizable material. Applicants respectfully submit that the articles having the claimed structure are novel regardless of how they are made. Support for claims 61-73 can be found throughout the specification and more specifically on page 11, lines 5-12 and page 13, line 27 to page 14, line 19, where it is clear that electrospinning is one, albeit preferred, embodiment for forming the claimed articles.

III. Rejections:

On page 2 of the Office Action, Claims 1, 2, 3, 6, 7, 13, 14, 26, 27, 28, 31, 32, 38 and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dzenis et al., "Polymer Hybrid Nano/Micro Composites" (hereinafter "Dzenis").

Claims 1-39 are directed to a biodegradable and/or bioabsorbable fibrous article, which includes a composite (or asymmetric composite) of different biodegradable and/or bioabsorbable fibers. As discussed in the telephone interview, Applicants respectfully submit that Dzenis does not disclose, teach or suggest a composite of biodegradable and/or bioabsorbable fibers.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053, (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the claim.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Accordingly, as Dzenis does not disclose each and every element as set forth in the claims, i.e., biodegradable and/or bioabsorbable fibers, it is respectfully submitted that Dzenis does not anticipate the presently claimed invention. As such it is requested that the rejections of claims 1, 2, 3, 6, 7, 13, 14, 26, 27, 28, 31, 32, 38 and 39 in view of Dzenis be withdrawn.

On page 3 of the Office Action, Claims 1-45 and 52-55 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,685,956 ("the '956 patent").

The '956 patent issued from application serial no. 09/859,007. The instant application is a divisional of application no. 10/375,329, which issued as U.S. Patent No. 6,689,374 ("the '374 patent"), which, in turn, is a divisional of the 859,007 application.

Claims 1-24 of the '956 patent were original claims 49-72 in the 859,007 application. Claims 1-45 (of the instant application) were original claims 1-45 in the 859,007 application and claims 52-55 (of the instant application) were original claims 101-104 in the 859,007 application. The above claims were subject to a restriction requirement issued on January 22, 2003 (Paper No.5), during prosecution of the 859,007 application. A copy of the restriction requirement is attached as Exhibit A for the Examiner's convenience. A review of the restriction requirement reveals that it considered claims 1-24 of the '956 patent to be a different invention from the inventions claimed in claims 1-45 and 52-55 of the instant application.

Accordingly, in light of the restriction requirement, it is respectfully submitted that the '956 patent cannot be cited as prior art to claims 1-45 and 52-55. See 35 U.S.C. §121; see

also MPEP 804.01. Therefore, it is respectfully requested that the rejections of claims 1-45 and 52-55 in view of the '956 patent be withdrawn.

On page 4 of the Office Action, claims 56-60 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of the '374 patent.

Similar to the '956 patent, as discussed above, the restriction requirement in the 859,007 application (Ex. A) considered claims 1-25 of the '374 patent to be a different invention from the invention claimed in claims 56-60 of the instant application.

Accordingly, in light of the restriction requirement, it is respectfully submitted that the '374 patent cannot be cited as prior art to claims 56-60. See 35 U.S.C. §121; see also MPEP 804.01. Therefore, it is respectfully requested that the rejections of claims 56-60 in view of the '374 patent be withdrawn.

On page 5 of the Office Action, claims 56 and 58-60 were rejected under 35 U.S.C. § 101 as claiming the same invention as claims 26-29 of the '374 patent.

Claims 56 and 58-60 are directed to a method for providing controlled tissue healing, while claims 26-29 of the '374 patent are directed to a method for controlled delivery of a medicinal agent. Moreover, these claims were considered to be different inventions in the restriction requirement in the 859,007 application (Ex. A).

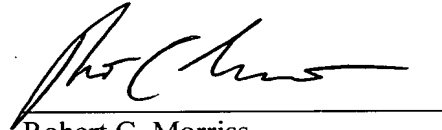
Accordingly, in light of the restriction requirement, it is respectfully submitted that the '374 patent cannot be cited as prior art to claims 56 and 58-60. See 35 U.S.C. §121; see also MPEP 804.01. Therefore, it is respectfully requested that the rejections of claims 56 and 58-60 in view of the '374 patent be withdrawn.

Applicant: Chu et al.
Serial No: 10/719,290
Filed: November 21, 2003
Page 15

CONCLUSION

Applicants respectfully submit that the application is now in proper form for allowance, which action is earnestly solicited. If resolution of any remaining issue is required prior to allowance of the application, it is respectfully requested that the Examiner contact Applicants' attorney at the telephone number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert C. Morriss', written over a horizontal line.

Robert C. Morriss
Registration No.: 42,910
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550
RCM:jp